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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,574	02/05/2001	Takashi Takenaga	P107156-00047	9571

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EXAMINER


DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

 Office Action Summary	Application No. 09/775,574	Applicant(s) TAKENAGA, TAKASHI	
	Examiner Arthur Duran	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 3 have been examined.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/3/05 has been entered.

Response to Amendment

3. The Amendment filed on 2/5/05 is sufficient to overcome the DeLorme reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme (5,948,040) in view of Drury (6,707,421).

DeLorme is considered to disclose the claimed system comprising:

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an advertisement site for displaying the advertisements the map image displayed on said user terminal, including a advertisement server for displaying route setting and advertisements situated along the set route on the map image, a route database storing road data on a map required for setting server, advertisement data (column 14 lines 1-42),

wherein said advertisement server sets a route based on the road data stored said route database, and read out advertisements situated along the set route from said a route in said advertisement database storing registered advertisement database to display them on the user terminal (column 14 lines 53-65). DeLorme is considered to also disclose the claimed user profile matching (column 16 lines 60-65) and user registration (column 31 lines 52-67).

Additionally, De Lorme discloses a map with points of interest (Fig 1a, item 109); a map and route with advertisements along the route (Fig. 1b-3; Fig. 5; Fig. 5d) a database connecting places and routes (Fig. 3, Geographic Data) that geographic points of interest and advertisements can be displayed along with the map or route setting (col 1, lines 35-46; col 1, line 57-col 2, line 2; col 6, lines 37-41; col 13, lines 5-10; col 47, lines 45-60).

De Lorme further discloses the use of a server (col 10, lines 10-17; col 14, line 65-col 15, line 15).

De Lorme further discloses that the information provided via TRIPS can be paid for by third-party providers of goods or services (col 30, lines 25-32) and that third-parties can offer special offers for goods and services available through TRIPS (col 6, lines 31-37). Hence, the information provided by TRIPS is functionally equivalent to advertisements.

De Lorme further discloses providing relevant advertisements along with the map (col 35, lines 49-56).

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Also, De Lorme discloses a map with points of interest (Fig 1a, item 109); a map and route with advertisements along the route (Fig. 1b-3; Fig. 5; Fig. 5d) a database connecting places and routes (Fig. 3, Geographic Data) that geographic points of interest and advertisements can be displayed along with the map or route setting (col 1, lines 35-46; col 1, line 57-col 2, line 2; col 6, lines 37-41; col 13, lines 5-10; col 47, lines 45-60).

De Lorme further discloses the use of a server (col 10, lines 10-17; col 14, line 65-col 15, line 15).

De Lorme further discloses that the information provided via TRIPS can be paid for by third-party providers of goods or services (col 30, lines 25-32) and that third-parties can offer special offers for goods and services available through TRIPS (col 6, lines 31-37). Hence, the information provided by TRIPS is functionally equivalent to advertisements.

De Lorme further discloses providing relevant advertisements along with the map (col 35, lines 49-56).

Additionally, the online Merriam-Webster dictionary defines 'advertisement' as,

"1 : the act or process of advertising

2 : a public notice; *especially* : one published in the press or broadcast over the air"

, and 'advertising' as,

"1 : to make something known to : NOTIFY

2 a : to make publicly and generally known <*advertising* their readiness to make concessions> b

: to announce publicly especially by a printed notice or a broadcast c : to call public attention to

especially by emphasizing desirable qualities so as to arouse a desire to buy or patronize :

PROMOTE *intransitive senses* : to issue or sponsor advertising".

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Also, DeLorme discloses the utilization of an advertising server (Fig 9b, item 904; col 10, lines 10-17; col 14, line 65-col 15, line 15). DeLorme further discloses the presentation of advertising (col 36, lines 64-69; col 55, lines 20-25; col 61, lines 53-57; col 62, lines 33-40; col 63, lines 7-15; col 64, lines 17-25; col 64, line 65-col 65, line 5). Also, De Lorme discloses a map with points of interest (Fig 1a, item 109); a map and route with advertisements along the route (Fig. 5, Fig. 5d) a database connecting places and routes (Fig. 3, Geographic Data) that geographic points of interest and advertisements can be displayed along with the map or route setting (col 1, lines 35-46; col 1, line 57-col 2, line 2; col 6, lines 37-41, col 13, lines 5-10; col 47, lines 45-60).

Additionally, DeLorme discloses registering users:

"FIGS. 8A and 8B, details the TRIPS Accounting Subsystem, including membership enrollment or user registration functions, third party provider input/output, billing and ratings functions and relations with other TRIPS Subsystems in generating map/ticket output (col 13, lines 15-20);

(60) Hereinafter, for purposes of preferred online or Internet embodiments, FIG. 4 breaks down TRIPS retail output, differentiating access by registered or enrolled users to VALUABLE OUTPUT 447 as opposed to FREE OUTPUT 445 which is made available to anonymous Internet "surfers," as an enticement to become members or registered users. The retail consumer output block as outlined at 227 in FIG. 2, however, generally includes both the "free" and "valuable" varieties of online output (col 31, lines 59-67);

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(78) Whenever desired, user registration is achieved through the "REGISTER NOW" prompt at 407 in FIG. 4. This leads to "Accts." at 411 (i.e. "Accounts" abbreviated). Accts. corresponds to the Accounting Subsystem at 217 in FIG. 2 and the HOW? main input menu at 163 in FIG. 1C. To receive membership privileges on a TRIPS Internet site, users enroll through the USER REGISTRATION sub-menu, or by comparable means. Users register, "sign up" and/or set up an account by routine protocols for input of their name, address, credit card numbers and other personal or business data required or requested by the TRIPS Internet site proprietor. On account of such enrollment, or by user password entry, or by equivalent means, registered status is duly entered within the ACCOUNTING DATA sub-structure of the standard TRIPS data structure that evolves as part and parcel of the course of any TRIPS travel planning session--as detailed elsewhere in this disclosure with particular reference to FIGS. 3 and 8. As entered in the data structure of the current TRIPS travel planning session, the fact that the user is duly registered gets recognized at 439, and then permits access to and/or downloading of VALUABLE OUTPUT at 447 in FIG. 4" (col 37, lines 3-25).

DeLorme discloses utilizing user profiles and preferences for determining content offered to a user:

"(149) In FIG. 8A, access to TRIPS' VALUABLE outputs is contingent on user registration or membership enrollment. At 806, state-of-the-art software enables subscription, user registration or client enrollment, user access controls such as passwords for signing on, and user/member list management functions. Enrolled or registered TRIPS retail consumers can input individual profiles, preferences or personal travel planning operational parameters--i.e. more or less global settings for subsequent implementation, automatically or by

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default, in the course of their individual travel planning sessions or specific component operations performed in TRIPS. For example, a corporate client engaging a TRIPS online site to plan and arrange its employees' business trips can have its workers using TRIPS bound by standard profiles which specify preferred providers, impose budget limits, favor travel at certain times and otherwise encourage compliance with company travel policies. Individual user profiles save keystrokes and repetitive entry of routine information such as home address as departure point, nonsmoking preferences, preferred transportation modes or accommodation providers, even topical interests such as favorites foods, recreation or brands, and so forth (col 61, lines 5-26);

(183) By so identifying the individual remote user whose WCU 907 is sending a given transmission, the TRIPS service provider 904 can access the individual user account, user profile and "pre-filed" travel plan output (if any). These preliminary operations in the Accounting Subsystem determine that the TRIPS user is registered, initiate billing and other TRIPS transaction tracking procedures, and make available stored information about the user's identity, preferences and specific travel plan if one was submitted in advance" (col 74, lines 54-63).

DeLorme discloses offering advertising:

(151)... Certain TRIPS Internet sites will offer more FREE OUTPUT to attract traffic and maximize their advertising audience. TRIPS online services reserved for enrolled organization members will likely emphasize the benefits of all the VALUABLE OUTPUT made available to their registered users (col 61, line 50-65);

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(153) Added levels of variable DIFFERENTIAL ACCESS/OUTPUT can readily be included. Typical transactions discussed in the present TRIPS patent disclosure actually contemplate three DIFFERENTIAL ACCESS/OUTPUT levels. Firstly, in order to attract "traffic" or anonymous Internet "surfers", a prime level of FREE OUTPUT attracts an "audience" for the advertising offered on the site, and also creates a pool of prospective registered users and new members. Secondly, to reward or motivate user registration, setting up an account, becoming a member or at least user input of their personal name and address information, a second access/output level offers further increments of VALUABLE travel information OUTPUT and functions. Thirdly, users can get special offers and/or options to purchase goods/services--including diverse accommodation and transportation reservations and tickets--provided directly by the TRIPS site and/or brokered through participating third-party providers. These purchases involve a tertiary level of credit terms, conventional accounts and billing, "cyber-money" and/or electronic payments, or equivalent provisions for compensation or exchange of value to pay for goods or services ordered or optioned online in TRIPS (col 62, lines 29-51);

(154)... Certain types of substantive travel information can be FREE OUTPUTS e.g. larger scale or less detailed maps, publicly scheduled events, brief topical information texts, plus special offers which third-party providers paid to "post" or advertise, on a given TRIPS Internet site (col 63, lines 5-11);

(156) Participating third-party providers of TRIPS travel information and/or services are subject to various fees or charges, such as: commissions on reservations or ticket sales; charges for advertising or the online posting of promotional information and/or special coupon offers

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about diverse accommodations (e.g. restaurants, transportation, lodgings, entertainment, tickets, etc.) and/or various other related goods/services" (col 64, lines 15-25).

Drury discloses utilizing a server for targeting a user for advertising based on the user location, route, and/or user profile:

"(348) In another alternative version of the system, additional data is downloaded from the server system along with the route. For instance traffic information is downloaded and displayed to the operator. Also, advertising information, for example, for restaurants along the route are downloaded and displayed to the operator and the vehicle passes along the route. The downloaded additional data may be tailored to the individual driver by the server system, based on the vehicle identification it has received. For example, a driver's personal profile, or his pattern of previous travel can be used by the server to select advertising data to download to the vehicle for the in-vehicle system to present to the driver while he navigates the route (col 40, lines 51-65);

(380) Additional "third-party" data such as advertising may be sent to the information pod along with requested information. For instance, in addition to traffic information in the vicinity of the vehicle, advertising for restaurants or gas stations in the vicinity may be downloaded and presented to the driver as well. The downloaded data (e.g., advertising) can be customized to the driver based on the uploaded identification of the information pod. For instance, the server system may choose advertising based on the driver's previous travel pattern, on his actual location, or on some other personal profile available to the server system" (col 45, lines 20-30).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Drury's utilizing a server for targeting a user for advertising based on the user location, route, and/or user profile to DeLorme's utilizing of a server, targeted content, a user profile, advertising, and user location/route information. Furthermore, it would be obvious to DeLorme that the targeted advertising based on user profile of Drury can be utilized for all advertising content shown to the user. One would have been motivated to do this in order to provide advertising or content that will be of more likely interest to the user.

Response to Arguments

5. Applicant's arguments with respect to claims 1 and 3 have been considered but are moot in ground so the rejection above.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

Please particularly note the citations and rejection beginning at the last "Additionally, DeLorme discloses ..." in the rejection above.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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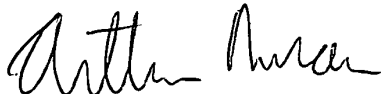
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur Duran
Patent Examiner
3//21/05